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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/820,649  
Filing Date: April 07, 2004  
Appellant(s): SCHUDER ET AL.

Edouard Garcia

For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 8 January 2010 appealing from the Office action mailed 12 August 2009.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

5,261,769	Leclerc	11-1993
6,422,281	Ensign, Jr. et al.	7-2002
5,261,996	Rossini	11-1993

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 9-12, 21-24, 27-29, and 36-39 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Leclerc (U.S. Patent 5,261,769) in view of Ensign, Jr., et al. (U.S. Patent 6,422,281).

Regarding claim 9, Leclerc discloses a bookbinding system 10, comprising: a sheet binder 12/34 configured to bind with an adhesive 44 two or more sheets 14 into an adhesively bound text body having an exposed spine 32 bounded by two exposed side hinge areas 66/70; an adhesive dispenser 50/82 configured to apply an adhesive 62/84 between a cover 20 and the side hinge areas of the text body; and a cover binder 16 configured to bind the cover to the side hinge areas of the text body by applying pressure to the cover (the cover binder 16 inherently applies pressure to the cover to attach it to the book block).

Leclerc does not disclose that the adhesive dispenser is configured to apply a solid pressure sensitive adhesive film. Ensign, Jr., et al. teaches the use of an adhesive dispenser 10 that applies a pressure sensitive adhesive made of one or more layers coated (i.e., a film) on a transfer substrate 170 wound around a core 168 in a plug-in cartridge 26 for the purpose of applying the adhesive layer to a selected substrate 186. Ensign, Jr., et al. also teaches that the system may be redesigned for industrial heavy use applications (see column 15, lines 59-61). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to have combined the bookbinding system of Leclerc with the pressure sensitive adhesive application system of Ensign, Jr., et al. in order to be able to replace the hot melt glue guns 50/82 with a pressure sensitive adhesive system that applies a well known alternative adhesive material. Furthermore, it would have been an obvious matter of design choice to load the adhesive dispenser with a transfer substrate having two laterally spaced apart adhesive films for the purpose of being able to use the bookbinding system to apply adhesive on both sides of the book block spine in order to replace the adhesives 62/84 of Leclerc.

Regarding claim 10, the modified invention of Leclerc discloses wherein the adhesive dispenser is configured to apply a solid pressure sensitive adhesive film to the cover in a series of spaced-apart strips (as modified by Ensign, Jr., et al.).

Regarding claim 11, the modified invention of Leclerc discloses wherein the adhesive dispenser comprises a plug-in cartridge housing 26 (as modified by Ensign, Jr., et al.).

Regarding claim 12, the modified invention of Leclerc discloses wherein the adhesive dispenser comprises a supply spool 168 disposed within the plug-in cartridge housing 26 and configured to support a roll of pressure sensitive adhesive tape formed from a solid pressure sensitive adhesive film disposed on a carrier ribbon 170 (as modified by Ensign, Jr., et al.).

Regarding claim 21, the modified invention of Leclerc discloses wherein the adhesive dispenser applies the solid pressure sensitive adhesive film to the cover before the cover binder contacts the applied solid pressure sensitive adhesive to the side hinge areas of the text body (the cover binder contacts the adhesive to the side hinge areas of the text body through intermediary contact with the crash 24, as seen in figures 1 and 2 of Leclerc and modified by Ensign, Jr., et al.).

Regarding claim 22, the modified invention of Leclerc discloses wherein the cover binder binds the cover to the spine of the text body by positioning a portion of the cover over the spine of the text body and applying pressure to the portion of the cover positioned over the spine of the text body (it is inherent, or in the alternative, obvious that the cover binder of Leclerc would apply pressure to the areas of the cover where the adhesive is attached to the cover for the purpose of adhering the adhesive to the book block).

Regarding claim 23, the modified invention of Leclerc discloses the invention substantially as claimed, except the modified invention of Leclerc does not disclose wherein the adhesive dispenser applies the solid pressure sensitive adhesive film as a single continuous strip with a width dimension that is wider than the exposed spine of

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the text body. However, by using the unmodified single strip adhesive film of Ensign, Jr., et al., it would have been an obvious matter of design choice to have selected an adhesive film that is a single continuous strip wider than the exposed spine of the text body for the purpose of having a cover that is attached to the entire crash 24 of the book block along the spine and side hinge areas, thereby making a stronger attachment between the cover and the crash.

Regarding claim 24, the modified invention of Leclerc discloses the invention substantially as claimed, except the modified invention of Leclerc does not disclose wherein the adhesive dispenser applies the solid pressure sensitive adhesive film in a series of multiple strips over an area corresponding to the side hinge areas and the exposed spine of the text body. However, it would have been an obvious matter of design choice to have selected an adhesive film that is made of 3 parallel strips for the purpose of having a cover that is attached to the crash 24 of the book block along with the side hinge areas, thereby making a stronger attachment between the cover, crash, and book block.

Regarding claim 27, the modified invention of Leclerc discloses wherein the cover binder contacts the side hinge areas to the applied solid pressure sensitive adhesive film (through contact with the crash 24).

Regarding claim 28, the modified invention of Leclerc discloses wherein the adhesive dispenser dispenses the solid pressure sensitive adhesive from a roll of solid sheet adhesive (as modified by Ensign, Jr., et al.).

Regarding claim 29, the modified invention of Leclerc discloses wherein the adhesive dispenser dispenses from the roll a solid sheet adhesive that comprises a pressure sensitive adhesive composition dispersed on a carrier ribbon 170 (as modified by Ensign, Jr., et al.).

Regarding claim 36, the modified invention of Leclerc discloses further comprising a roll of the solid sheet adhesive loaded in the adhesive dispenser (as modified by Ensign, Jr., et al.).

Regarding claim 37, the modified invention of Leclerc discloses wherein the cover binder positions the cover over the exposed side hinge areas and the exposed spine of the text body and applies pressure to the positioned cover to activate the pressure sensitive adhesive film (it is inherent that the cover binder of Leclerc would apply pressure to the cover for the purpose of adhering the adhesive to the book block).

Regarding claim 38, the modified invention of Leclerc discloses wherein the cover binder applies pressure to the positioned cover to activate the pressure sensitive adhesive film without applying heat (as modified by Ensign, Jr., et al.).

Regarding claim 39, the modified invention of Leclerc discloses the invention substantially as claimed, except the modified invention of Leclerc does not disclose wherein the adhesive dispenser applies the spaced-apart strips of the solid pressure sensitive adhesive film respectively over areas of the cover corresponding to the spine and the side hinge areas of the text body. However, it would have been an obvious matter of design choice to have selected an adhesive film that is made of 3 parallel strips for the purpose of having a cover that is attached to the crash 24 of the book



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block along with the side hinge areas, thereby making a stronger attachment between the cover, crash, and book block.

Claims 9-12, 21-24, 27-30, and 36-39 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Leclerc (U.S. Patent 5,261,769) in view of Rossini (U.S. Patent 5,261,996).

Regarding claim 9, Leclerc discloses a bookbinding system 10, comprising: a sheet binder 12/34 configured to bind with an adhesive 44 two or more sheets 14 into an adhesively bound text body having an exposed spine 32 bounded by two exposed side hinge areas 66/70; an adhesive dispenser 50/82 configured to apply an adhesive 62/84 between a cover 20 and the side hinge areas of the text body; and a cover binder 16 configured to bind the cover to the side hinge areas of the text body by applying pressure to the cover (the cover binder 16 inherently applies pressure to the cover to attach it to the book block).

Leclerc does not disclose that the adhesive dispenser is configured to apply a solid pressure sensitive adhesive film. Rossini teaches the use of an adhesive dispenser 10 that applies a pressure sensitive adhesive 34 made of one or more layers coated on a transfer substrate 48 wound around a core in a plug-in cartridge housing 42 (spool 42 is a plug-in cartridge housing in as much as the outer portion seen in figure 1 forms a cartridge housing containing a supply spool (inner portion on which roll of adhesive sits) that is plugged into the adhesive dispenser 10) for the purpose of applying discrete lengths of adhesive 12 to a selected substrate 14. Rossini also

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teaches that the system uses a take-up reel 46 for the transfer substrate 48. Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to have combined the bookbinding system of Leclerc with the pressure sensitive adhesive application system of Rossini in order to be able to replace the hot melt glue guns 50/82 with a pressure sensitive adhesive system that applies a well known alternative adhesive material. Furthermore, it would have been an obvious matter of design choice to load the adhesive dispenser with a transfer substrate having two laterally spaced apart adhesive films for the purpose of being able to use the bookbinding system to apply adhesive on both sides of the book block spine in order to replace the adhesives 62/84 of Leclerc. Also, although Rossini explicitly teaches an example in which the transfer substrate 48 covers the pressure sensitive adhesive strip 34 on the adhesive side of the strip, and is removed from the adhesive strip by take-up reel 46 prior to application to the selected substrate (column 8, lines 16-34), it is noted that Rossini discloses in column 6, lines 15-19, that "the strip of web material can be any tape, film, foil or the like..." Therefore, one of ordinary skill in the art at the time of the invention would have known to have selected a tape material having adhesive with a liner on both sides of the tape for use as a binding tape, this modification being both obvious and providing no unexpected results.

Regarding claim 10, the modified invention of Leclerc discloses wherein the adhesive dispenser is configured to apply a solid pressure sensitive adhesive film to the cover in a series of spaced-apart strips (as modified by Rossini, see column 7, lines 43-65).

Regarding claim 11, the modified invention of Leclerc discloses wherein the adhesive dispenser comprises a plug-in cartridge housing 42 (as modified by Rossini).

Regarding claim 12, the modified invention of Leclerc discloses wherein the adhesive dispenser comprises a supply spool (inner portion on which roll of adhesive sits) disposed within the plug-in cartridge housing (outer portion of 42 seen in figure 1) and configured to support a roll of pressure sensitive adhesive tape formed from a solid pressure sensitive adhesive film 34 disposed on a carrier ribbon 48 (as modified by Rossini).

Regarding claim 21, the modified invention of Leclerc discloses wherein the adhesive dispenser applies the solid pressure sensitive adhesive film to the cover before the cover binder contacts the applied solid pressure sensitive adhesive to the side hinge areas of the text body (the cover binder contacts the adhesive to the side hinge areas of the text body through intermediary contact with the crash 24, as seen in figures 1 and 2 of Leclerc and modified by Rossini).

Regarding claim 22, the modified invention of Leclerc discloses wherein the cover binder binds the cover to the spine of the text body by positioning a portion of the cover over the spine of the text body and applying pressure to the portion of the cover positioned over the spine of the text body (it is inherent, or in the alternative, obvious that the cover binder of Leclerc would apply pressure to the areas of the cover where the adhesive is attached to the cover for the purpose of adhering the adhesive to the book block).

Regarding claim 23, the modified invention of Leclerc discloses the invention substantially as claimed, except the modified invention of Leclerc does not disclose wherein the adhesive dispenser applies the solid pressure sensitive adhesive film as a single continuous strip with a width dimension that is wider than the exposed spine of the text body. However, by using the unmodified single strip adhesive film of Rossini, it would have been an obvious matter of design choice to have selected an adhesive film that is a single continuous strip wider than the exposed spine of the text body for the purpose of having a cover that is attached to the entire crash 24 of the book block along the spine and side hinge areas, thereby making a stronger attachment between the cover and the crash.

Regarding claim 24, the modified invention of Leclerc discloses the invention substantially as claimed, except the modified invention of Leclerc does not disclose wherein the adhesive dispenser applies the solid pressure sensitive adhesive film in a series of multiple strips over an area corresponding to the side hinge areas and the exposed spine of the text body. However, it would have been an obvious matter of design choice to have selected an adhesive film that is made of 3 parallel strips for the purpose of having a cover that is attached to the crash 24 of the book block along with the side hinge areas, thereby making a stronger attachment between the cover, crash, and book block.

Regarding claim 27, the modified invention of Leclerc discloses wherein the cover binder contacts the side hinge areas to the applied solid pressure sensitive adhesive film (through contact with the crash 24).

Regarding claim 28, the modified invention of Leclerc discloses wherein the adhesive dispenser dispenses the solid pressure sensitive adhesive from a roll of solid sheet adhesive (as modified by Rossini).

Regarding claim 29, the modified invention of Leclerc discloses wherein the adhesive dispenser dispenses from the roll a solid sheet adhesive that comprises a pressure sensitive adhesive composition dispersed on a carrier ribbon 48 (as modified by Rossini).

Regarding claim 30, Leclerc discloses a bookbinding system 10, comprising: a sheet binder 12/34 configured to bind two or more sheets 14 into a text body having an exposed spine 32 bounded by two exposed side hinge areas 66/70; an adhesive dispenser 50/82 configured to apply an adhesive 62/84 between a cover 20 and the side hinge areas of the text body; and a cover binder 16 configured to bind the cover to the side hinge areas of the text body by applying pressure to the cover (the cover binder 16 inherently applies pressure to the cover to attach it to the book block).

Leclerc does not disclose that the adhesive dispenser is configured to apply a solid pressure sensitive adhesive film, or wherein the adhesive dispenser dispenses the solid pressure sensitive adhesive from a roll of solid sheet adhesive that comprises a pressure sensitive adhesive composition dispersed on a carrier ribbon, and the adhesive dispenser applies the solid pressure sensitive adhesive film by releasing a film of the pressure sensitive adhesive composition from the carrier ribbon and reeling-in spent carrier ribbon. Rossini teaches the use of an adhesive dispenser 10 that applies a pressure sensitive adhesive film 34 from a roll of solid sheet adhesive dispersed on a

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carrier ribbon 48, and the adhesive dispenser applies the solid pressure sensitive adhesive film by releasing a film of the pressure sensitive adhesive composition from the carrier ribbon and uses a take-up reel 46 for the carrier ribbon 48, all for the purpose of applying discrete lengths of adhesive 12 to a selected substrate 14. Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to have combined the bookbinding system of Leclerc with the pressure sensitive adhesive application system of Rossini in order to be able to replace the hot melt glue guns 50/82 with a pressure sensitive adhesive system that applies a well known alternative adhesive material.

Regarding claim 36, the modified invention of Leclerc discloses further comprising a roll of the solid sheet adhesive loaded in the adhesive dispenser (as modified by Rossini).

Regarding claim 37, the modified invention of Leclerc discloses wherein the cover binder positions the cover over the exposed side hinge areas and the exposed spine of the text body and applies pressure to the positioned cover to activate the pressure sensitive adhesive film (it is inherent that the cover binder of Leclerc would apply pressure to the cover for the purpose of adhering the adhesive to the book block).

Regarding claim 38, the modified invention of Leclerc discloses wherein the cover binder applies pressure to the positioned cover to activate the pressure sensitive adhesive film without applying heat (as modified by Rossini).

Regarding claim 39, the modified invention of Leclerc discloses the invention substantially as claimed, except the modified invention of Leclerc does not disclose

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wherein the adhesive dispenser applies the spaced-apart strips of the solid pressure sensitive adhesive film respectively over areas of the cover corresponding to the spine and the side hinge areas of the text body. However, it would have been an obvious matter of design choice to have selected an adhesive film that is made of 3 parallel strips for the purpose of having a cover that is attached to the crash 24 of the book block along with the side hinge areas, thereby making a stronger attachment between the cover, crash, and book block.

Claims 13 and 30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Leclerc (U.S. Patent 5,261,769) in view of Ensign, Jr., et al. (U.S. Patent 6,422,281) and further in view of Rossini (U.S. Patent 5,261,996).

Regarding claim 13, the modified invention of Leclerc discloses wherein the adhesive dispenser comprises a take-up spool disposed within the plug-in cartridge housing and configured to reel-in spent carrier ribbon. Rossini teaches the use of an applicator system that applies an adhesive material 34 in the form of a tape that is adhered to a carrier ribbon 48, further comprising a take-up reel 46 for the purpose of reeling in the spent carrier ribbon. Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to have combined the bookbinding system of Leclerc and Ensign, Jr., et al. with the take-up reel of Rossini in order to automatically remove and store the spent carrier ribbon.

Regarding claim 30, Leclerc discloses a bookbinding system 10, comprising: a sheet binder 12/34 configured to bind two or more sheets 14 into a text body having an

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exposed spine 32 bounded by two exposed side hinge areas 66/70; an adhesive dispenser 50/82 configured to apply an adhesive 62/84 between a cover 20 and the side hinge areas of the text body; and a cover binder 16 configured to bind the cover to the side hinge areas of the text body by applying pressure to the cover (the cover binder 16 inherently applies pressure to the cover to attach it to the book block).

Leclerc does not disclose that the adhesive dispenser is configured to apply a solid pressure sensitive adhesive film, or wherein the adhesive dispenser dispenses the solid pressure sensitive adhesive from a roll of solid sheet adhesive that comprises a pressure sensitive adhesive composition dispersed on a carrier ribbon, and the adhesive dispenser applies the solid pressure sensitive adhesive film by releasing a film of the pressure sensitive adhesive composition from the carrier ribbon and reeling-in spent carrier ribbon. Ensign, Jr., et al. teaches the use of an adhesive dispenser 10 that applies a pressure sensitive adhesive made of one or more layers coated (i.e., a film) on a transfer substrate 170 wound around a core 168 in a plug-in cartridge 26 for the purpose of applying the adhesive layer to a selected substrate 186. Ensign, Jr., et al. also teaches that the system may be redesigned for industrial heavy use applications (see column 15, lines 59-61). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to have combined the bookbinding system of Leclerc with the pressure sensitive adhesive application system of Ensign, Jr., et al. in order to be able to replace the hot melt glue guns 50/82 with a pressure sensitive adhesive system that is easy to maintain. Furthermore, it would have been an obvious matter of design choice to load the adhesive dispenser with a transfer substrate



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having two laterally spaced apart adhesive films for the purpose of being able to use the bookbinding system to apply adhesive on both sides of the book block spine in order to replace the adhesives 62/84 of Leclerc.

Rossini teaches the use of an applicator system that applies an adhesive material 34 in the form of a tape that is adhered to a carrier ribbon 48, further comprising a take-up reel 46 for the purpose of reeling in the spent carrier ribbon. Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to have combined the bookbinding system of Leclerc and Ensign, Jr., et al. with the take-up reel of Rossini in order to automatically remove and store the spent carrier ribbon.

#### **(10) Response to Argument**

Appellant's arguments filed 12 May 2009 have been fully considered but they are not persuasive.

It is noted that on page 6 of 27, Appellant states that "The Examiner has relied upon Rossini to make-up for this lack of disclosure". However, this section of the arguments is directed to the rejection of Leclerc in view of Ensign, so it has been assumed that Appellant meant to say that "The Examiner has relied upon Ensign".

Appellant argues on pages 6 and 7 that "Ensign does not teach or suggest an adhesive dispenser that is configured to "replace the hot melt glue guns 50/82" nor does Ensign disclose or suggest an adhesive dispenser that is able to apply "two laterally spaced apart adhesive films for the purpose of being able to use the bookbinding

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system to apply adhesive on both sides of the book block spine", and "There is no readily apparent way to configure Ensign's adhesive transfer apparatus such that it could "replace the hot melt glue guns 50/82" or be able to apply "two laterally spaced apart adhesive films for the purpose of being able to use the bookbinding system to apply adhesive on both sides of the book block spine", and "Ensign's adhesive transfer apparatus is expressly designed for the purpose of applying pressure-sensitive adhesive over the entire surface of the selected substrate so that, at some later time, the selected substrate can be peeled off the transfer substrate for adherence to a desired contact surface". However, it is noted that Ensign teaches in column 15, line 56 to column 16, line 11, that "the principles of the present invention are not limited by size and the apparatus of a large size for industry heavy use applications", implying that the invention of Ensign is capable of being used for large scale applications beyond the scope of the embodiment in the drawings, and that while a preferred embodiment of the invention teaches a substrate with a similar width as the mask instead of a substrate of greater width, "this feature is preferred and not necessary and should not be considered to limit the invention". One of ordinary skill in the art at the time of the invention would have found it obvious to have modified the teachings of Ensign to obtain a bookbinding system as claimed in independent claim 9 because the substitution of one known element for another would have yielded predictable results, as the combination merely relies upon replacing the hot melt adhesive system with a properly sized pressure sensitive adhesive system that supplies two spaced apart adhesive films instead of one for the purpose of supplying adhesive on both sides of the book block spine.

Appellant argues on pages 7 and 8 that "the Examiner's proposed modification of Leclerc's bookbinding apparatus would not result in the inventive subject matter defined in claim 9 because the side hinge areas of the cover would not be bound to the text body. As shown clearly in FIG 6 of Leclerc, however, the adhesives 62/84 bind the crash 29 to the side portions 64/68 of the cover, but the crash is not bound to the sides 66, 70 of the text block 70." However, it is noted that the appropriate embodiment is shown in figures 7 and 8, and column 3, lines 44-55 of Leclerc states that "the glue gun 50 applies a first strip of adhesive 62 (FIGS. 7 and 8) to the first portion 64 of the cover 20 for covering the first side 66 of the book block 14. A glue gun 82 (FIG. 2) applies a second strip of adhesive 84 to the second portion 68 of the cover 20 for covering the second side 70 of the book block 14". Therefore Leclerc teaches that the adhesive is used to bind the side hinge areas of the cover to the text body, and the modification using the pressure sensitive adhesive of Ensign would build on this teaching.

In the last paragraph of page 9, the Appellant points to the column 16, lines 1-9 teachings of Ensign to show that using a selected substrate that is wider than the mask substrate would not work, and on page 10 that "Ensign's adhesive transfer apparatus is purposefully designed to apply pressure-sensitive adhesive over an entire surface of a selected substrate". However, Appellant ignores the teaching of Ensign in column 16, lines 9-11 that states "this feature is preferred and not necessary and should not be considered to limit the invention". Therefore Ensign teaches that while there may be complications using this configuration, it is still possible and should be considered.

Appellant argues on page 11 that “Moreover, even if it were possible to modify Ensign's adhesive transfer apparatus to be able to apply “two laterally spaced apart adhesive films” over selected portions of the cover, such a modification would have obviated the need for the key inventive element of Ensign's invention: namely: the provision of an adhesive mask substrate that automatically removes all excess adhesive that extends beyond the edges of the selected substrate so that “There is no need to handle or discard the mask substrate 166 because it is wound up on the take-up roll 136” (col. 11, lines 65-67; also see col. 2, lines 1-31). A modification that obviates the underlying need or purpose of an invention hardly would be an obvious modification. For this reason, Ensign effectively teaches away from the Examiner's proposed modification of Leclerc's booking system”. However, this argument is not persuasive because all of the mask substrate would be taken up by the take-up roll 136 in the combination as applied in the rejection of claim 9. Only the two adhesive strips and the transfer substrate 170 on top of the strips would remain on the book cover 20 of Leclerc (the modified selected substrate 186 of Ensign), the transfer substrate then being peeled back to uncover the adhesive so that the cover could be adhered to the book block according to the teachings in column 11, lines 62-65 of Ensign.

Appellant argues on page 14 that “In accordance with Rossini's disclosure, the adhesive tape is a web material that has a single adhesive side with a pressure sensitive adhesive or other adhesive and an overlying protective release layer 48 (see col. 8, lines 19-34). When used with such a tape, the applicator machine 10 removes protective release layer 48 and applies the exposed adhesive side of the tape to a

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substrate with the non-adhesive side of the tape facing away from the substrate.

Applied in this way, the adhesive tape does not constitute "a solid pressure sensitive adhesive film" that is suitable for application between a cover and a the side hinge areas of a text body and subsequent use in binding the cover to the side hinge areas of the text body by applying pressure to the cover". However, Rossini teaches in column 6, lines 15-19 that "the strip of web material can be any tape, film, foil or the like...", and one of ordinary skill in the art at the time of the invention would have known to have selected a tape material having adhesive with a liner on both sides of the tape for use as a binding tape, this modification providing no unexpected results.

Appellant's argument on page 15 concerning the placement of the adhesives 62/84 of Leclerc is essentially the same as that set forth in the arguments on pages 7 and 8, which was addressed above and therefore does not need to be readdressed.

Appellant's argument on page 16 is moot as it was taught above that one of ordinary skill in the art would have selected a tape with adhesive on both sides of the tape.

Appellant's argument on page 18 that "Rossini does not teach that the take-up spool reels in the web material 34, which serves as the carrier ribbon on which the adhesive is disposed. Instead, Rossini teaches that the take-up reel 46 is used to wind up the waste strip of a protective release layer 48 (which is separate and distinct from the adhesive carrying web material 34)". However, Rossini was not relied upon to teach that the adhesive film was disposed on a carrier ribbon, that being taught by Ensign in claim 12. Rossini was only relied upon to teach that a carrier ribbon could be reeled in

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by a take-up reel, and for this teaching the protective release layer 48 may be considered to be a carrier ribbon as it carries the adhesive material 34 until it is removed by the take-up reel.

Appellant's arguments concerning the rejection of independent claim 30 have been addressed by the responses to the similar rejections above.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Eric A. Gates/

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/DAVID P. BRYANT/

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